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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,217	02/13/2002	Pascal Nicolle	SCHN : 019	4817

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PARKHURST & WENDEL, L.L.P.  
1421 PRINCE STREET  
SUITE 210  
ALEXANDRIA, VA 22314-2805

EXAMINER
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NAHAR, QAMRUN

ART UNIT	PAPER NUMBER
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2124

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/073,217	<b>Applicant(s)</b> NICOLLE ET AL.	
	<b>Examiner</b> Qamrun Nahar	<b>Art Unit</b> 2124	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>02/13/2003</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is in response to the preliminary amendment filed on 02/13/2002.
2. Claims 4, 8 and 12 have been amended.
3. Claims 1-12 are pending and have been examined.

### ***Oath/Declaration***

4. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because: the foreign priority date is recited as "19 February 2002", where it should recite "19 February 2001"; and furthermore, some of the text for Residence and Post Office Address for Inventor Christian Tuccinardi is not legible, please correct.

### ***Specification***

5. The abstract of the disclosure is objected to because the label "Figure 1" on line 15 of pg. 48 must be deleted. Correction is required. See MPEP § 608.01(b).
6. The disclosure is objected to because of the following informalities: Section labels for each section of the specification is missing.

Appropriate correction is required.

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

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### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or  
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

7. The disclosure is objected to because of the following informalities: the specification is replete with the word "hierarchised", which should be "hierarchical".

Appropriate correction is required.

*Claim Objections*

8. Claims 1-2, 4-9 and 11-12 are objected to because of the following informalities: these claims contain parenthetical references to the drawings, where the references should be removed.

Appropriate correction is required.

9. Claims 1-12 are objected to because of the following informalities: “characterised” should be “characterized”. Appropriate correction is required.

10. Claims 1-3 and 9-10 are objected to because of the following informalities: these claims contain the word “hierarchised” on lines 7, 4, 2, 9 and 2 of the claims, respectively, where the word should be “hierarchical”. Appropriate correction is required.

11. Claim 5 is objected to because of the following informalities: “according claim 3” on line 1 of the claim should be “according to claim 3”. Appropriate correction is required.

12. Claim 8 is objected to because of the following informalities: “dialoguing” on line 4 of the claim should be “communicating”. Appropriate correction is required.

13. Claim 8 is objected to because of the following informalities: delete the word “firstly” on line 4 of the claim. Appropriate correction is required.

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14. Claim 8 is objected to because of the following informalities: delete the word “also” on line 7 of the claim. Appropriate correction is required.

15. Claim 9 is objected to because of the following informalities: “its memory” on line 6 of the claim should be “the memory”. Appropriate correction is required.

16. Claim 11 is objected to because of the following informalities: “application description files” on line 3 of the claim should be “description files”. Appropriate correction is required.

17. Claim 12 is objected to because of the following informalities: “in memory” on line 5 of the claim should be “in **the** memory”. Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

18. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

19. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

20. Claim 1 recites the limitation “the compacted format” in lines 9-10 of the claim. There is insufficient antecedent basis for this limitation in the claim. Therefore, this limitation is interpreted as “a compacted format”.

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Claims 2-8 are rejected for dependency upon rejected base claim 1 above.

21. Claim 1 recites the limitation "the contents" in lines 10-11 of the claim. There is insufficient antecedent basis for this limitation in the claim. Therefore, this limitation is interpreted as "contents".

Claims 2-8 are rejected for dependency upon rejected base claim 1 above.

22. Claims 1 and 2 recite the limitation "the application" in lines 12 and 5 of the claims, respectively. There is insufficient antecedent basis for this limitation in the claims. Therefore, this limitation is interpreted as "the automation application".

Claims 3-8 are rejected for dependency upon rejected base claim 1 above.

23. Claims 1 and 2 recite the limitation "it uses" on lines 13 and 2 of the claims, respectively. This limitation renders the claims indefinite because it is unclear to what entity the "it" is referring to. Therefore, this limitation is interpreted as "the programming station uses".  
Appropriate correction is required.

Claims 3-8 are rejected for dependency upon rejected base claim 1 above.

24. Claims 3, 8 and 10 recite the limitation "the XML language" in lines 3, 7 and 3 of the claims, respectively. There is insufficient antecedent basis for this limitation in the claims. Therefore, this limitation is interpreted as "XML language".

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Claims 5-7 and 11-12 are rejected for dependency upon rejected base claims 3, 8 and 10 above.

25. Claim 6 recites the limitation "the tags" in line 3 of the claim. There is insufficient antecedent basis for this limitation in the claim. Therefore, this limitation is interpreted as "tags".

26. Claim 8 recites the limitation "it includes" on lines 2-3 of the claim. This limitation renders the claim indefinite because it is unclear to what entity the "it" is referring to. Therefore, this limitation is interpreted as "the programming station includes". Appropriate correction is required.

27. Claim 8 recites the limitation "(Mng1, Mng2, etc.)" in line 8 of the claim. This limitation renders the claim indefinite because the word "etc." indicates that there are more unspecified database managers. Please delete the word "etc.". Appropriate correction is required.

28. Claim 8 recites the limitation "(Db1, Db2, etc.)" in line 10 of the claim. This limitation renders the claim indefinite because the word "etc." indicates that there are more unspecified databases. Please delete the word "etc.". Appropriate correction is required.



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29. Claim 8 recites the limitation "the tree structure representative" in lines 5-6 of the claim. There is insufficient antecedent basis for this limitation in the claim. Therefore, this limitation is interpreted as "a tree structure representative".

30. Claim 8 recites the limitation "one of the databases" in line 10 of the claim. There is insufficient antecedent basis for this limitation in the claim. Therefore, this limitation is interpreted as "one of plurality of databases".

31. Claim 9 recites the limitation "the form" in lines 2-3 of the claim. There is insufficient antecedent basis for this limitation in the claim. Therefore, this limitation is interpreted as "a form".

Claims 10-12 are rejected for dependency upon rejected base claim 9 above.

32. Claim 9 recites the limitation "the automation application" in lines 8-9 of the claim. There is insufficient antecedent basis for this limitation in the claim. Therefore, this limitation is interpreted as "the automation application program".

Claims 10-12 are rejected for dependency upon rejected base claim 9 above.

33. Claims 11 and 12 recite the limitation "it comprises" on line 2 of the claims. This limitation renders the claims indefinite because it is unclear to what entity the "it" is referring to. Therefore, this limitation is interpreted as "the automation equipment comprises". Appropriate correction is required.

34. Claim 12 recites the limitation "the compacted language" in line 3 of the claim. There is insufficient antecedent basis for this limitation in the claim. Therefore, this limitation is interpreted as "the compacted format".

***Claim Rejections - 35 USC § 101***

35. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

36. Claims 9-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claim 9, merely claimed as a program representing a computer listing *per se* (automation application program), that is, descriptions or expressions of such a program and that is, descriptive material *per se*, non-functional descriptive material, and is not statutory because it is not a physical "thing" nor a statutory process, *as there are not "acts" being performed*. Such claimed programs do not define any structural and functional interrelationships between the program and other claimed aspects of the invention which permit the program's functionality to be realized. Since a computer program is merely a set of instructions capable of being executed by a computer, the program itself is not a process, without the computer-readable medium needed to realize the program's functionality. In contrast, a claimed computer-readable medium encoded with a program defines structural and functional interrelationships between the program and the medium which permit the program's functionality to be realized, and is thus statutory.

**Warmerdam**, 33 F.3d at 1361, 31 USPQ2d at 1760. **In re Sarkar**, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978). See MPEP § 2106(IV)(B)(1)(a).

It is suggested that claim 9 be amended to recite the claimed automation application program performing a function and/or step.

As per claims 10-12, these claims are rejected for dependency on the above rejected non-statutory claim 9.

***Claim Rejections - 35 USC § 102***

37. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

38. Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Muenzel (US 2002/0004804 A1).

**Per Claim 1 (as best understood):**

The Muenzel publication discloses:

- **programming station for an automation application designed to be executed in an automation equipment, the programming station comprising a memory containing a set of one or several description files, each description file describing part of the automation**

**application and being expressed in a single, hierarchical and object oriented language (pg. 3, par. 0027; and see Figure 1, item 26)**

**- characterized in that the programming station uses a compression program that generates a file in a compacted format for each description file, contents of the compacted file being sufficient for the description of part of the automation application considered, and in that the programming station uses a loading program to store each compacted file in a memory in the automation equipment (pg. 3, par. 0038 to pg. 4, par. 0040; and see Figure 2, item 64).**

**Per Claim 2 (as best understood):**

The Muenzel publication discloses:

**- characterized in that the programming station uses a decompression program to generate a description file in a single, hierarchical and object oriented language describing part of the automation application, from a compacted file stored in the automation equipment memory (pg. 4, par. 0041).**

**Per Claim 3 (as best understood):**

The Muenzel publication discloses:

- characterized in that the single, hierarchical and object oriented language is XML language (pg. 3, par. 0027).

**Per Claim 4 (as best understood):**

The Muenzel publication discloses:

- characterized in that the set of description files contains an application program description file, an application input-output description file, and an application data description file (pg. 2, par. 0012).

**Per Claim 5 (as best understood):**

The Muenzel publication discloses:

- characterized in that the compression program and the decompression program comprise two steps (pg. 3, par. 0038 to pg. 4, par. 0041).

**Per Claim 6 (as best understood):**

The Muenzel publication discloses:

- characterized in that the compression program comprises a step to reduce tags contained in a description file expressed in the XML language by application of a specific stylesheet

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**and a step to execute a compaction algorithm adapted to XML files (pg. 4, par. 0042, lines 1-13).**

**Per Claim 7 (as best understood):**

The Muenzel publication discloses:

**- characterized in that the decompression program comprises a step to execute a decompaction algorithm adapted to XML files and a step to recreate source tags contained in a description file expressed in the XML language, by application of a specific stylesheet (pg. 4, par. 0042, lines 13-16).**

**Per Claim 8 (as best understood):**

The Muenzel publication discloses:

**- characterized in that the programming station includes an XML handler in a non-volatile memory communicating through notifications with a management module of a tree structure representative of the automation application expressed in XML language, and with a plurality of database managers (Mng1, Mng2), each manager being specific to part of the automation application stored in one of plurality of databases (Db1, Db2) (pg. 5, par. 0055).**

**Per Claim 9 (as best understood):**

The Muenzel publication discloses:

**- automation equipment comprising a memory containing an automation application program in a form of a binary file executable by the automation equipment, characterized in that the automation equipment stores the executable file in the memory, together with one or several files in compacted format output from a set of one or more description files(s) describing the automation application program and expressed in a single, hierarchical and object oriented language (pg. 3, par. 0027 and par. 0038; and see Figure 1, item 26).**

**Per Claim 10 (as best understood):**

The Muenzel publication discloses:

**- characterized in that the single, hierarchical and object oriented language is XML language (pg. 3, par. 0027).**

**Per Claim 11 (as best understood):**

The Muenzel publication discloses:

**- characterized in that the automation equipment comprises translation means in order to convert description files expressed in the XML language into a binary file that can be**

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**executed by the automation equipment** (pg. 3, par. 0038 to pg. 4, par. 0040; and see Figure 2, item 64).

**Per Claim 12 (as best understood):**

The Muenzel publication discloses:

**- characterized in that the automation equipment comprises means of decompressing a file in the compacted format to a description file in XML language by using a specific stylesheet stored in the memory** (pg. 4, par. 0041).

***Conclusion***

39. Any inquiry concerning this communication from the examiner should be directed to Qamrun Nahar whose telephone number is (571) 272-3730. The examiner can normally be reached on Mondays through Thursdays from 8:30 AM to 6:00 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki, can be reached on (571) 272-3719. The fax phone number for the organization where this application or processing is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications



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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

QN

January 6, 2005

A handwritten signature in black ink, appearing to read 'TODD INGBERG', with a long, sweeping horizontal line extending to the right.

**TODD INGBERG  
PRIMARY EXAMINER**